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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,682	10/31/2001	Akihiro Yoshitani	CANO:039	2566

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EXAMINER

HUNTSINGER, PETER K

ART UNIT	PAPER NUMBER
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2625

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/016,682

Applicant(s)

YOSHITANI ET AL.

Examiner

Peter K. Huntsinger

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 12/1/06 have been fully considered but they are not persuasive.

The applicant argues on page 7 of the response in essence that:

Misawa selects the transmission type based exclusively on the image size (i.e. two-dimensional image size), not based on the image data size.

- a. The examiner respectfully disagrees. Misawa discloses making the transmission type selection (col. 8, lines 10-21) based on the file size (col. 4-5, lines 59-67, 1-6+). The reference value which determines the transmission type selection is disclosed as 1 MB.

The applicant argues on pages 7 and 8 of the response in essence that:

Altering the image size after the transmission selection process would defeat the purpose of making the transmission selection exclusively based on the image size.

- b. Misawa discloses making the transmission type selection (col. 8, lines 10-21). Kim discloses altering the size of the image to match a predetermined image size (i.e. two-dimensional image size) for transmission by facsimile if the image represented by the input image data is smaller than the predetermined image size (col. 3, lines 58-63). This combination does not destroy the reference of Misawa because the size determining the method of transmission (i.e. data

size) is not the same as the predetermined image size the image data is altered to be (i.e. two-dimensional image size). As an example, selecting the transmission type based on a 1 MB reference value (i.e. data size), the system of Misawa would utilize facsimile transmission if the file is greater than 1 MB. After facsimile transmission is selected, the image data size (i.e. two-dimensional image size) would be determined and altered if less than a predetermined image size. Further, the data size and the two-dimensional image size are unrelated (i.e. a 2x2cm image could have a greater data size than a 10x10cm image).

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 16 and 18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 16 and 18 are drawn to functional descriptive material NOT claimed as residing on a computer readable medium. MPEP 2106.IV.B.1(a) (Functional Descriptive Material) states:

"Data structures not claimed as embodied in a computer-readable medium are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer."

"Such claimed data structures do not define any structural or functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized."

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Claims 16 and 18, while defining a storage medium, does not define a "computer-readable medium" and is thus non-statutory for that reason. A storage medium can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the claim to embody the program on "computer-readable medium" in order to make the claim statutory.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4, 6-12, and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Misawa et al. Patent 6,771,382, and further in view of Kim Patent 6,268,937.

Referring to claims 1, 15, and 16, Misawa et al. disclose an image processing apparatus (composite communication apparatus 10 of Fig. 1, col. 3, lines 19-35) comprising: an inputter arranged to input image data representing an image (image reading unit 15 of Fig. 1, col. 3, lines 19-35); a first producer arranged to produce data for transmission by facsimile based on the image data input by said inputter (facsimile unit 80 of Fig. 1, col. 3, lines 19-35); a second producer arranged to produce data for transmission by electronic mail based on the image data input by said inputter (email

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transmission unit 17 of Fig. 1, col. 3, lines 19-35); and a controller arranged to control said first and second producers in a manner such that when the data for transmission by electronic mail is produced by said second producer, the data for transmission by electronic mail is produced without the image data input by said inputter being processed by a processor (col. 8, lines 10-21). Misawa et al. do not disclose expressly altering the size of the image to a predetermined image size if the image is to be sent by facsimile. Kim discloses a processor arranged to process image data input by an inputter in a manner such that the image represented by the image data has a predetermined image size; and when the data for transmission by facsimile is produced by a first producer, the data for transmission by facsimile is produced after the image data input by said inputter is processed by said processor to alter the size of the image represented by the input image data to match the predetermined image size for transmission by facsimile if the image represented by the input image data is smaller than the predetermined image size (col. 3, lines 58-63). Misawa et al. and Kim are combinable because they are from the same field of facsimile communication. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add white pixels to an image to reach a predetermined image size when the image is sent via facsimile. The motivation for doing so would have been compensate for the difference between the original image size and the transmission size. Therefore, it would have been obvious to combine Kim with Misawa et al. to obtain the invention as specified in claims 1, 15, and 16.

Referring to claim 2, Misawa et al. disclose an image processing apparatus according to claim 1, wherein said inputter inputs the image data from a reader which reads the image and generates the image data based on the image (image reading unit 15 of Fig. 1, col. 3, lines 19-35).

Referring to claim 3, Misawa et al. disclose an image processing apparatus according to claim 1, wherein said inputter inputs the image data from a detachable memory (image reading unit 15 of Fig. 1, col. 3, lines 19-35). Misawa et al. disclose that the scanner can be separate from the composite communication apparatus (col. 7, lines 31-52). It is inherent that the scanner has memory for receiving image data. The scanner can be detached from the system because it is a separate device, therefore the image reading unit 15 is a detachable memory.

Referring to claim 4, Kim discloses wherein said processor processes the image data input by an inputter by adding white pixels thereto so as for the image represented by the image data to have a predetermined size if the image represented by the input image data is smaller than the predetermined image size (col. 3, lines 58-63).

Referring to claim 6, Misawa et al. disclose an image processing apparatus according to claim 1, wherein said controller restricts operations of said first and second producers according to a predetermined condition (S16 of Fig. 4, col. 5, lines 16-21).

Referring to claims 7, 17, and 18, Misawa et al. disclose an image processing apparatus (composite communication apparatus 10 of Fig. 1, col. 3, lines 19-35) comprising: an inputter arranged to input image data representing an image (image reading unit 15 of Fig. 1, col. 3, lines 19-35); a first producer arranged to produce data

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for transmission by facsimile based on the image data input by said inputter (facsimile transmission unit 14 of Fig. 1, col. 3, lines 19-35); and a second producer arranged to produce data for transmission by electronic mail based on the image data input by said inputter (email transmission unit 17 of Fig. 1, col. 3, lines 19-35). Misawa et al. do not disclose expressly altering the size of the image to a predetermined image size if the image is to be sent by facsimile. Kim discloses a processor that alters image data input by an inputter; and a controller arranged to control a process to be performed on the image data input by said inputter according to a size of the image represented by the image data input by said inputter, wherein when the size of the image represented by the image data input by said inputter is smaller than a predetermined image size and the image data input by said inputter is to be transmitted by facsimile, said controller supplies the image data input by said inputter to a first producer after the processor alters the image data prior to facsimile transmission (col. 3, lines 58-63). Misawa et al. and Kim are combinable because they are from the same field of facsimile communication. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add white pixels to an image to reach a predetermined image size when the image is sent via facsimile. The motivation for doing so would have been compensate for the difference between the original image size and the transmission size. Therefore, it would have been obvious to combine Kim with Misawa et al. to obtain the invention as specified in claims 7, 17, and 18.

Referring to claim 8, Misawa et al. disclose an image processing apparatus according to claim 7, wherein said inputter inputs the image data from a reader which

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reads the image and generates the image data based on the image (image reading unit 15 of Fig. 1, col. 3, lines 19-35).

Referring to claim 9, Misawa et al. disclose an image processing apparatus according to claim 7, wherein said inputter inputs the image data from a detachable memory (image reading unit 15 of Fig. 1, col. 3, lines 19-35). Misawa et al. disclose that the scanner can be separate from the composite communication apparatus (col. 7, lines 31-52). It is inherent that the scanner has memory for receiving image data. The scanner can be detached from the system because it is a separate device, therefore the image reading unit 15 is a detachable memory.

Referring to claim 10, Kim discloses wherein the processor alters the image data such that the size of the image represented by the image data input by said inputter becomes equal to the predetermined image size (col. 3, lines 58-63).

Referring to claim 11, Misawa et al. disclose an image processing apparatus according to claim 7, wherein when the image data input by said inputter is to be transmitted by electronic mail, said controller causes said second producer to produce a file corresponding to the size of the image represented by the image data input by said inputter (col. 5, lines 16-21).

Referring to claim 12, Misawa et al. disclose an image processing apparatus according to claim 11, wherein when the image data input by said inputter to be transmitted by electronic mail is set as the file having a predetermined size, said controller causes said second producer to produce the file having the predetermined

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size irrespective of the size of the image represented by the image data input by said inputter (S62 of Fig. 6, col. 6, lines 34-39).

5. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Misawa et al. Patent 6,771,382 and Kim Patent 6,268,937 as applied to claim 1 above, and further in view of Morigami Patent 6,057,934.

Referring to claim 5, Misawa et al. disclose wherein said controller controls said first producer and said second producer. Misawa et al. do not disclose expressly using different gamma values for producing the data. Morigami discloses different gamma values in producing data for facsimile and monitors (col. 9, lines 65-67). Misawa et al. and Morigami are combinable because they are from the same field of image processing. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to produce an image for facsimile transmission with a different gamma value than producing an image for email. The motivation for doing so would have been to utilize typical gamma values in producing the images to obtain accurate images. Therefore, it would have been obvious to combine Morigami with Misawa et al. to obtain the invention as specified in claim 5.

6. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Misawa et al. Patent 6,771,382 and Kim Patent 6,268,937 as applied to claim 7 and 13, and further in view of well known prior art.

Referring to claim 13, Misawa et al. disclose an image processing apparatus according to claim 7, wherein said controller inhibits supply of the image data input by said inputter to said first and second producers (S61 and S81 of Fig. 6, col. 6, lines 30-32, 54-56). Misawa et al. do not disclose expressly inputting a color image. Official Notice is taken that it is well known to a person of ordinary skill in the art to input, fax, and email a color image (See MPEP 144.03). The motivation for doing so would have been to allow transmitting more vibrant images through email and fax.

Referring to claim 14, Misawa et al. disclose an image processing apparatus according to claim 13, wherein the image represented by the image data input by said inputter is a size smaller than a predetermined size, said controller permits supply of the image data input by said inputter to said first and second producers (S61 and S81 of Fig. 6, col. 6, lines 30-32, 54-56). Misawa et al. do not disclose expressly inputting a color image. Official Notice is taken that it is well known to a person of ordinary skill in the art to input, fax, and email a color image (See MPEP 144.03). The motivation for doing so would have been to allow transmitting more vibrant images through email and fax.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

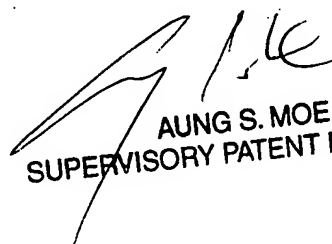
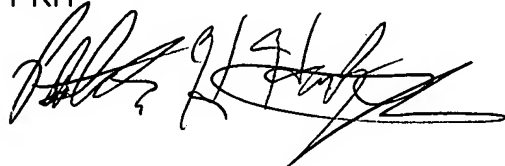
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter K. Huntsinger whose telephone number is (571)272-7435. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Moe Aung can be reached on (571)272-7314. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PKH



2/16/02
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SUPERVISORY PATENT EXAMINER